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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,205	10/28/2003	Bennett M. Richard	304-35713-US (D5407-216)	4513
25397 7590 05/12/2009 DUANE MORRIS LLP - Houston 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027				
EXAMINER				
COZART, JERMIE E				
ART UNIT		PAPER NUMBER		
3726				
MAIL DATE		DELIVERY MODE		
05/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/695,205

Applicant(s)

RICHARD ET AL.

Examiner

Jermie E. Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/26/09 (and BPAI decision of 10/31/08).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Reopening Prosecution after Board of Patent Appeals and Interferences Decision

Inventorship

In view of the papers filed 2/26/09, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding inventors Matt Falgout, Don Simoneaux, and Kendall Dyson.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Allowable Subject Matter

1. The indicated allowability of claims 10, 11, and 15 is withdrawn in view of the newly discovered reference(s) to Broome et al. (US 6,305,468 B1), Rudd (US 2004/0003927 A1), Brissette et al. (US 6,698,076 B2), and Layne (1,854,517). Rejections based on the newly cited reference(s) follow.
2. Claims 16 and 17 are allowed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-7, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudd (US 2004/0003927) in view of Brissette et al. (US 6,698,076 B2).

Regarding claim 1, Rudd discloses manufacturing a screen for downhole use wherein a base pipe (14) is inserted into a filter layer (22), and the filter layer (22) is secured to the base pipe (14) by being mechanically coupled (specifically, reducing the diameter of the outer filter layer by plastically deforming the filter layer against the outer surface of the base pipe; pg. 3, paragraph [0051]; pg. 5, paragraph [0072]).

Regarding claims 2 and 9, Rudd discloses creating an interference fit (pg. 3, paragraph [0049], lines 6-14) between the base pipe (14) and the filter layer (20).

Regarding claim 4, Rudd discloses reducing (pg. 3, paragraph [0049], lines 6-14) the size of the filter layer by first expanding the diameter of the filter layer to a second diameter greater the base pipe outer diameter then allowing the filter layer to return to its original smaller diameter.

Regarding claim 5, Rudd discloses accomplishing the securing (pg. 3, paragraph [0049], lines 2-3) the filter layer (22) to the base pipe (14) without welding, adhesive, or mechanical connectors.

Regarding claim 6, Rudd discloses inserting the base pipe (14) and filter layer (22) downhole (pg. 4, paragraph [0065], lines 1-3) and expanding (pg. 4, paragraph [0065], lines 6-9; Fig. 3) the base pipe (14) downhole.

Regarding **claim 10**, Rudd discloses manufacturing a screen for downhole use by inserting a base pipe (14) into a filter layer (22), securing the filter layer (22) to the base pipe (14) by changing one of the dimensions (pg. 3, paragraph [0049], lines 6-14) thereby creating an interference fit between the base pipe 914) and filter layer (22), securing (pg. 3, paragraph [0049], lines 2-3) the filter layer (22) to the base pipe (14) without welding, adhesives, or mechanical connectors, installing the base pipe (14) and filter layer downhole (pg. 4, paragraph [0065], lines 1-3), and expanding (pg. 4, paragraph [0065], lines 6-9; Fig. 3) the base pipe (14) downhole.

Regarding **claim 11**, Rudd discloses mounting (pg. 4, paragraph [0067], lines 15-18) an outer tube (18) which is essentially a protective jacket after inserting the base pipe (14).

Regarding **claim 12**, Rudd discloses expanding the base pipe (14) for at least a portion of the length of the filter layer (22) due to running-in a rotary expansion tool along the length of the inner tube (14). *See paragraph [0065] for further clarification.*

Regarding **claim 13**, Rudd discloses expanding the base pipe (14) near the ends of the filter layer (22) due to running-in a rotary expansion tool along the length of the inner tube (14). *See paragraph [0065] for further clarification.*

Regarding **claim 14**, Rudd discloses expanding the base pipe (14) for the entire length of the filter layer (22) and beyond due to running-in a rotary expansion tool along the length of the inner tube (14). *See paragraph [0065] for further clarification.*

Rudd, however, does not disclose securing the filter layer to the base pipe by expanding the base pipe, expanding the base pipe then securing the filter to the base pipe, or mounting a protective jacket to the filter layer before inserting the base pipe.

Brissette discloses securing an outer layer member (14) to an inner layer member (12) by using one of two embodiments: (A) expanding (col. 3, lines 58-61 and FIG. 3; col. 4, lines 15-17 and FIG. 4) the inner layer member (12) into the outer member (14) in order to form an interlocking profile between the members (12, 14), or (B) inserting the inner member (12) within the outer member (14) and then pushing the two members through a die (56; FIG. 5) and mandrel (58) to form an interlocking profile. Brissette thus teaches that it was well known in the art to secure inner and outer tubular members to one another interchangeably by using either expansion of the inner tubular member against the inner surface of the outer tubular member, or compression of the outer tubular member against the outer surface of the inner tubular member.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to expand the base pipe of Rudd to secure the base pipe to the filter layer (rather than reduce the diameter of the outer filter layer to secure it to the base pipe), in light of the teachings of Brissette that outward expansion and inward compression are art-recognized equivalent options for connecting concentric tubular sections, the selection of either process being well obvious and well within the level of ordinary skill in the art.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to mount a protective jacket to the

filter layer before inserting the base pipe because Applicant has not disclosed that mounting a protective jacket to the filter layer before inserting the base pipe provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with mounting the protective jacket to the filter layer after the base pipe is inserted into the filter layer as taught by Layne because the protective jacket is effectively mounted to the filter layer.

Therefore, it would have been an obvious matter of design choice to further modify Rudd to obtain the invention as specified in claim 7.

5. Claims 1, 2, 4, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broome et al. (US 6,305,468 B1) in view of Brissette et al. (US 6,698,076 B2).

Regarding claim 1, Broome discloses manufacturing a screen for downhole use wherein a base pipe (34) is inserted into a filter layer (20), and the filter layer (20) is secured to the base pipe (34) by passing (col. 3, lines 45-47) the filter layer (20) together with the base pipe (34) through die (32). As the concentric base pipe and filter layer are passed through the die, the filter layer is compressed against the outer surface of the base pipe to secure them to each other.

Regarding claims 2 and 9, Broome discloses creating an interference fit (col. 3, line 67 – col. 4, line 1) between the base pipe (34) and the filter layer (20).

Regarding claim 4, Broome discloses reducing the size of the filter layer (20) by passing the base pipe (34) along with the filter layer (20) through die (32).

Regarding claim 5, Broome discloses accomplishing the securing (col. 3, lines 45-47) the filter layer (20) to the base pipe (34) without welding, adhesive, or mechanical connectors.

Broome, however, does not disclose securing the filter layer to the base pipe by expanding the base pipe.

Brissette discloses securing an outer layer member (14) to an inner layer member (12) by using one of two embodiments: (A) expanding (col. 3, lines 58-61 and FIG. 3; col. 4, lines 15-17 and FIG. 4) the inner layer member (12) into the outer member (14) in order to form an interlocking profile between the members (12, 14), or (B) inserting the inner member (12) within the outer member (14) and then pushing the two members through a die (56; FIG. 5) and mandrel (58) to form an interlocking profile. Brissette thus teaches that it was well known in the art to secure inner and outer tubular members to one another interchangeably by using either expansion of the inner tubular member against the inner surface of the outer tubular member, or compression of the outer tubular member against the outer surface of the inner tubular member.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to expand the base pipe of Broome to secure the base pipe to the filter layer (rather than reduce the diameter of the outer filter layer to secure it to the base pipe), in light of the teachings of Brissette that outward expansion and inward compression are art-recognized equivalent options for connecting concentric tubular sections, the selection of either process being well obvious and well within the level of ordinary skill in the art.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Layne (1,854,517).

Regarding claim 15, Layne discloses inserting a base pipe (10) in a filter layer (20), applying a material (15) to the base pipe (10) to contact the filter layer (20) before the inserting, and applying heat (page 2, lines 66-70) to the filter layer (20) to allow the filter layer (20) and the material (15) to secure the filter layer (10) to the base pipe (10).

Layne, however, does not disclose applying heat to the base pipe.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to apply heat to the base pipe because Applicant has not disclosed that applying heat to the base pipe provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with applying heat to the filter layer as taught by Layne because the filter layer is shrunk fit tight enough upon the base pipe.

Therefore, it would have been an obvious matter of design choice to modify Layne to obtain the invention as specified in claim 15.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie E. Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jermie E Cozart/
Primary Examiner, Art Unit 3726

May 8, 2009

/DONALD HAJEC/

Director, Technology Center 3700